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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,642	04/02/2004	Kia Silverbrook	HYC007US	9566
24011 7590 03/10/2008 SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA				
EXAMINER				
UBER, NATHAN C				
ART UNIT		PAPER NUMBER		
4143				
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03/10/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/815,642

**Applicant(s)**

SILVERBROOK ET AL.

**Examiner**

NATHAN C. UBER

**Art Unit**

4143

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-38 is/are rejected.  
7) ☒ Claim(s) 26 and 27 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-850)  
Paper No(s)/Mail Date 12 Feb 2007, 18 Oct 2004 and 07 Oct 2004.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_



## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the application filed on 2 April 2004.
2. Claims 1-38 are currently pending and have been examined.

### **Information Disclosure Statement**

3. The Information Disclosure Statements filed 12 February 2007, 18 October 2004 and 07 October 2004 have been considered. Initialed copies of the Form 1449 are enclosed herewith.

### **Claim Objections**

4. Claims 26 and 27 each recite the limitation "the system of claim..." in the preambles, however they refer to claims which are methods, not systems (claims 23 and 26 respectively). Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form.

### **Drawings**

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they are replete the reference characters not mentioned in the description. For example, see at least reference characters 10011, 10012, 10800, 10841, and 10802. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim defines a coupon as a *netpage* coupon. There is no clear definition of *netpage* in the specification. For the purposes of this examination, Examiner interprets *netpage* to mean "a surface such as a page is printed with a collection of invisible tags" (pp 14 line 36 of the specification).

### Double Patenting

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).
9. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.
10. Claims 1-12, 14, 17-20, 22-25, and 28-38 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-50 of prior U.S. Patent No. 7,137,549. This is a double patenting rejection.

**Claim Rejections - 35 USC § 102**

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.
13. Claims 1-7, 13-19, 21-26 and 28-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Murphy et al. (4,554,446).

**Claims 1-7, 13-17, 23-26, and 29-38:**

Murphy discloses an inventory control method that uses a combination of machine readable and human readable indicia on product labels and coupons to track inventory, manage pricing, and conduct various incentive promotions electronically using a combination of point of sale machines and computers. (See at least Figures 1 and 2, see also column 4, lines 27-32). Product identification is discussed with reference to the UPC code (see at least column 3, lines 60-66). Murphy particularly notes several different types of coupons including coupons disposed on the product itself as well as coupons that require the customer to transmit customer identification data to the product manufacturer. Murphy points out that in situations where coupons require interaction from the customer, many customers cannot be bothered (a sentiment echoed in applicant's specification), so Murphy solved this problem by creating coded forms and ID cards so that the customer can simply transmit requisite personal information electronically by swiping or

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entering their coded information. The coupon redemption methods are discussed broadly in columns 9 and 10. Lines 9/18-29, 9/48-61 and 10/22-46 are particularly relevant to applicant's claims directed towards transmission of coupon and customer information as well as submitting electronic forms.

**Claims 18, 19, 21 and 22:**

Murphy discloses an inventory control system that uses a combination of machine readable and human readable indicia on product labels and coupons to track inventory, manage pricing, and conduct various incentive promotions electronically using a combination of point of sale machines and computers. (See at least Figures 1 and 2, see also column 4, lines 27-32). Product identification is discussed with reference to the UPC code (see at least column 3, lines 60-66).

**Claim 28:**

Murphy discloses coupons and labels with human and machine readable indicia (see at least column 4, lines 27-32, see also Figure 3).

**Claim Rejections - 35 USC § 103**

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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16. Claims 8 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy (U.S. 4,554,446) in view of Gray (GB 2 141 665).

**Claims 8 and 20:**

Murphy discloses the limitations as shown in the rejections above. Murphy does not disclose accumulating data relative to the position of the sensing device and the product labels. However, Gray discloses a method of identifying the position of labels and other indicia on products, particularly when those labels or the product were tampered with. The Gray invention uses a combination of human-visible and human-invisible inks on the product. It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the visible/invisible ink fraud detection system of Gray with the computer based inventory and coupon control system of Murphy because such a combination helps to reign in potential fraud in the coupon redemption art which Murphy teaches "...is so loose as to allow many other aspects of fraud to be perpetrated in the participants... [it is estimated] that fraudulently redeemed coupons range as high as \$350 million each and every year" (Murphy, column 3, lines 36-41).

17. Claims 9, 21 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy (U.S. 4,554,446) in view of Pingel et al. (DE 40 22 822).

**Claims 9 and 27:**

Murphy discloses the limitations as shown in the rejections above. Murphy does not disclose using human-invisible ink, however Pingel, discloses a printing technique for packaging or labels that uses human readable ink and non-human readable ink that is nonetheless machine readable and can be used to denote instructions for programming or control or for directing inventory in warehouses or for transportation control (See at least the abstract of the disclosure and the use/advantage section of the disclosure). It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the visible/invisible ink technique of Pingel with the inventory and coupon control system of Murphy because coded information useful to the Murphy invention can be printed right over product packaging, coupon instructions, and advertising serving the purposes of the store inventory system without affecting the

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manufacturer's advertising, product packaging or promotional objectives which ultimately reduces costs for both parties.

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### **Conclusion**

18. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James A Reagan** can be reached at **571.270.6710**.
19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
20. Any response to this action should be mailed to:

### **Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

or faxed to **571-273-8300**.

21. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building  
401 Dulany Street  
Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 4143  
5 March 2008

/James A. Reagan/Supervisory Patent Examiner, Art Unit 4143